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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,996	07/26/2000	R. Dean Adams	FIS9-2000-0138US1	8495

30743 7590 12/04/2003

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EXAMINER	
CHAUDRY, MUJTABA M	

ART UNIT	PAPER NUMBER
2133	

DATE MAILED: 12/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/625,996	ADAMS ET AL.	
	Examiner	Art Unit	
	Mujtaba K Chaudry	2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8 and 10-17* is/are pending in the application.

4a) Of the above claim(s) *2 and 9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-8 and 10-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *19* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

Applicant's arguments/amendments with respect to amended claims 1, 3, 8, 12 and 17, original claims 4-7, 10-11 and 13-16, and cancelled claims 2 and 9 filed September 23, 2003 have been fully considered but are not persuasive. The Examiner would like to point out that this action is made final. The 35 USC 112 rejections and objections in previous office actions have been addressed below. The IDS papers have been addressed below.

Applicant contends, "...the means for generating default test instructions which includes an initialization storage means is not shown by the reference to Schwartz." The Examiner, upon reexamination and reconsideration, disagrees with Applicant. It is pointed out by Applicant (Paper No. 18) "it should be noted that manufacturing and board level tests require initialization storage..." The Schwartz reference teaches as depicted in Figure 2 a buffer 206 which is attached to the external data line. According to the ***The Authoritative Dictionary of IEEE Standards Terms*** 7th edition, a buffer is defined as "a device in which data are stored temporarily, in the course of transmission from one point to another; used to compensate for a difference in the flow of data, supervisory control, data acquisition and automatic control." Therefore the buffer 206 taught by Schwartz is analogous to the initialization storage module of the present application.

Claim Objections

Claim 1 is objected to because of the following informalities:

- The phrase "a built in self test **arrangement**" needs to read as "built in self test **controller**" as described in the specification.
- In line 2, the term "including" needs to be changed to "comprising" as directed by MPEP.

Appropriate correction is required.

Claim 8 is objected to because of the following informalities:

- In line 2, the term "including" needs to be changed to "comprising" as directed by MPEP.

Appropriate correction is required.

Claim 6 is objected to because of the following informalities:

- In the preamble of the claim it is stated, "An integrated circuit as **received** in claim 5..." This should read as, "An integrated circuit as **recited** in claim 5..."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: initialization storage means and integrated circuit. The Examiner

would like to point out that it is not clear in the claims' language as written how the initialization storage means is related, essential or connected to the remaining apparatus.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the preamble of the claim it states, "**An integrated circuit including an embedded memory and a built-in self-test arrangement including**..." Now it is not clear if every limitation that follows the preamble is included in the **built-in self-test arrangement** or in the **embedded memory.** The Examiner would like to point out that the language of Claim 8 does not have this ambiguity. Furthermore, as a note, the Examiner would like to point out that the claim language is literally stating to **store** and **differentiate** between manufacturing and board test instructions, not actual testing.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being unpatentable over Schwartz (USPN 5982681). See Paper No. 7, 10 and 15.

The Examiner disagrees with the Applicant and maintains rejections with respect to amended claims 1, 3, 8, 12 and 17 and original claims 4-7, 10-11 and 13-16. All arguments have been considered. It is the Examiner's conclusion that amended claims 1, 3, 8, 12 and 17 and original claims 4-7, 10-11 and 13-16 are not patentably distinct or non-obvious over the prior art of record. See Paper No. 7, 10 and 15. Furthermore, the Examiner would like point out that newly filed IDS (Paper No.19) has been considered and PTO-1449 is attached hereto along with additional pertinent prior arts or record for the Applicant to read/review.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiries concerning this communication should be directed to the examiner, Mujtaba Chaudry who may be reached at 703-305-7755. The examiner may normally be reached Mon – Thur 7:30 am to 4:30 pm and every other Fri 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Albert DeCady at 703-305-9595. The fax phone number for the organization where this application is assigned is 703-746-7239.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the receptionist at 703-305-3900.

Mujtaba Chaudry
Art Unit 2133
November 23, 2003

ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100